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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dominic Dough-Ming Cheung

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BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE

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CHICAGO, IL 60610

EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3696

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/922,028	<b>Applicant(s)</b> CHEUNG ET AL.	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 72-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 72-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/06/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 72-79 are pending. Claim 72 has been amended in this communication filed 03/07/08 entered as Response After Non-Final Action. Claims 72, 74, 75, and 77-79 were amended in the communication filed 1/17/08.
2. The IDS filed 6/06/08 has been considered and entered.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 72 rejected under 35 U.S.C. 102(a) as being anticipated by (US 6,078,866) Buck et al, hereafter Buck.

Claim 72. Buck discloses, A database searching apparatus comprising:

Buck did not expressly disclose that the server is an account management server.

However, a server which can be used for this purpose in col. 10, line 52 and col. 12, line 37, a search engine in data communication with the account management server and operative to provide search results including search listings according to rank (col. 6, lines 48-61 and col. 3, line 35 -col. 4, line 12 and lines 49-59); and a database searchable by the search engine and including a plurality of search listings, at least some search listings being associated with advertisers (Fig.'s 1A and 1B), the search

listing associated with an advertiser including a search term specified by the advertiser (col. 7, lines 15-28), and a desired rank specified by the advertiser for a search listing and a maximum cost per click (maximum CPC) and a cost per click (CPC) associated with the desired rank for the search term and the advertiser, wherein, when the advertiser enters a new search listing or changes the maximum CPC of a search listing the account management server is operative, to adjust the CPC of the advertiser's search listing to maintain the desired rank, the account management server is operative to move the search listing to the highest rank possible without exceeding the maximum CPC of the advertiser's search listing (col. 7, line 58-col. 8, line 38 and col. 8, lines 42-67), the account management server is operative to maintain the CPC of the advertiser's search listing less than or equal to the maximum CPC of the advertiser's search listing, the account management server is operative to set the CPC of the advertiser's search listing no higher than necessary (col. 9, lines 1-13), and the account management server is operative to avoid setting the CPC of the advertiser's search listing so that desired ranks and CPCs of other advertisers are maintained (col. 9, lines 16-31). The fact that the server is an account management server does not change the result that is achieved. Infact, for the server to be an account management server does not change its intended use.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or

Art Unit: 3696

described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 73-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,078,866) Buck et al, hereafter Buck in view of Official Notice.

Claim 73. Buck failed to disclose, The database searching apparatus of claim 72 wherein the database further stores a timestamp associated with each desired rank, the timestamp indicated time the search listing was entered or changed. Official Notice is taken that it is old and well known for a database to store a timestamp associated with the desired rank and the timestamp to indicate the time the search listing was entered or changed. It is well known that in the Internet art that web pages are timestamped and can be ranked and placed in database storage with the time the web page was last modified or ranked.

Claim 74. Buck discloses, the database searching apparatus of claim 73 wherein the search engine is configured to receive a search request (col. 1, lines 44-55 -Background Art); locate one or more search listings having a matching relationship with the search request (col. 1, line 66-co1.2, line 11 (Background Art); and order search results from the one or more search listings using the CPC associated with the one or more search listings (col. 3, line 53-col. 4, line 47).

Claim 75. Buck failed to disclose, The database searching apparatus of claim 72 further

Art Unit: 3696

comprising: an account manager accessible by the advertiser to vary at least one of the maximum cost per click and the desired rank for a respective bid and desired rank. Official Notice is taken that a bid and a desired rank is well known when bidding on advertisement placement or bidding on most things a person desires a rank according to their bid.

Claim 76. Buck failed to disclose, The database searching apparatus of claim 75 wherein the account manager is further accessible by the advertiser to vary the maximum cost per click for two or more possible ranks specified by the advertiser. It is well known in the art of advertising on the Internet to pay per clickthrough for ranking in advertising.

Claim 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,078,866) Buck et al, hereafter Buck in view of Official Notice and further in view of "Mobile Agents".

Claim 77. Buck failed to disclose, The database searching apparatus of claim 72 further comprising: one or more software agents configured to receive advertiser bid information, and act on the advertiser bid information to adjust the cost per click for a specified search listing. "Mobile Agents" discloses, The database searching apparatus of claim 72 further comprising: one or more software agents configured to receive advertiser bid information, and act on the advertiser bid information to adjust the cost per click for a specified search listing (pages 1(3) -page 4(4)). It would have been obvious to one having ordinary skill in the art at the time the invention was made to

incorporate the teachings of "Mobile Agents" in Buck because such an incorporation would allow Buck to have a more efficient way of receiving advertiser bid information.

Claim 78. Buck discloses, The database searching apparatus of claim 77 wherein the one or more software agents is configured: to increase the current cost per click of the specified search listing if the rank of the specified search listing can be improved without exceeding the maximum cost per click (col. 4, lines 13-48); and decrease the current cost per click of the specified search listing without moving the specified search listing to a rank worse than the desired rank (col. 4, line 49-co1.5, line 3 and line 62-co1.6, line 67).

Claim 79. Buck discloses, The database searching apparatus of claim 78 wherein the one or more software agents are configured to decrease the current cost per click of the specified search listing only if no other search listing will have its respective current cost per click increased to decrease the rank of the specified search listing (col. 7, line 57-co1.8, line 38).

### ***Response to Arguments***

Applicant's arguments filed 03/07/08 have been fully considered but they are not persuasive.

Issue no. 1: applicants' argue: Buck and the other cited references fail to disclose search listings which include a desired rank or a maximum CPC, and fails to disclose an account management server which is operative in the manner defined by claim 72 in response to a maximum CPC and desired rank and Buck fails to include the innovation of a desired rank and maximum CPC as part of a search listing which can be used by

Art Unit: 3696

an account management server to order search listings has been considered but is not persuasive. Response: The Examiner does not interpret the account management server as having been part of the claim recitation prior to Applicants' amendment making this argument moot. Furthermore, the addition of an account management server is an intended use.

MPEP 2144.02. If Applicant does not traverse the Examiner's assertion of Official Notice or Applicants' traverse is not adequate, the Examiner should clearly indicate in the next Office Action that the common knowledge or well-known in the art statement is taken to be admitted prior art because Applicants' either failed to traverse the Examiner's assertion of Official notice or that the traverse was inadequate.

Applicants' failed to discuss or even mention the NPL reference "Mobile Agents" therefore it is considered that this reference reads on the claim limitations of Applicants' invention.

## PRINCIPLES OF LAW

### *Claim Construction*

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541,550 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

### *Obviousness*

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* 127 S.Ct. at 1739, 82



USPQ2d at 1395.

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill in the art can implement a predictable variation, § 103 likely bars its patentability." Id. 127 S. Ct. at 1740, USPQ2d at 1396. "For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." Id.

"Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." 127 S. Ct. at 1742, USPQ2d at 1397.

Prior art is not limited to the references being applied. Prior art includes both the specialized understanding of one of ordinary skill in the art, and common understanding of the layman. Examiners may rely on, for example, official notice, common sense, design choice, and ordinary ingenuity. See *Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976) and *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, - F.3d - -, 82 USPQ2d 1687 (Fed. Cir. 2007).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3696

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3696

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

June 12, 2008

<div>Application Number</div> <div></div>	Application/Control No.	Applicant(s)/Patent under Reexamination	
	09/922,028	CHEUNG ET AL.	
	Examiner	Art Unit	
	Ella Colbert	3696	